DEPARTMENT OF COMMERCE **[3510-16]**

United States Patent and Trademark Office

[Docket No. PTO-T-2012-0031]

Request for Comments Regarding Amending the First Filing Deadline for Affidavits or Declarations of Use or Excusable Nonuse

AGENCY: United States Patent and Trademark Office, Commerce

ACTIONS: Request for comments.

SUMMARY: To further ensure the accuracy of the trademark register, the United States Patent and Trademark Office ("USPTO") is seeking public comment on a potential legislative change to amend the first filing deadline for Affidavits or Declarations of Use or Excusable Nonuse under Sections 8 and 71 of the Trademark Act from between the fifth and sixth years after the registration date, or the six-month grace period that follows, to between the third and fourth years after the registration date, or the six-month grace period that follows. The change would require Congress to amend the Trademark Act, and the USPTO is interested in receiving public input on whether and why such an amendment is or is not favored.

DATES: Written comments must be received on or before [insert date 60 days from the date of publication in the Federal Register].

ADDRESSES: The USPTO prefers that comments be submitted via electronic mail message to TMFRNotices@uspto.gov. Written comments may also be submitted by mail to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, attention

Cynthia C. Lynch; by hand delivery to the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, Virginia, attention Cynthia C. Lynch; or by electronic mail message via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (http://www.regulations.gov) for additional instructions on providing comments via the Federal eRulemaking Portal. All comments submitted directly to the Office or provided on the Federal eRulemaking Portal should include the docket number (PTO–T–2012–0031). The comments will be available for public inspection on the USPTO's Web site at http://www.uspto.gov, and will also be available at the Office of the Commissioner for Trademarks, Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Because comments will be made available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included.

FOR FURTHER INFORMATION CONTACT: Cynthia C. Lynch, Office of the Deputy Commissioner for Trademark Examination Policy, at (571) 272-8742.

SUPPLEMENTARY INFORMATION

A Section 8 or 71 affidavit of continued use is a sworn statement that the mark is in use in commerce, filed by the owner of a registration. If the owner is claiming excusable nonuse of the mark, a Section 8 or 71 affidavit of excusable nonuse may be filed. The purpose of the Section 8 or 71 affidavit is to ensure the accuracy of the trademark register by removing "deadwood," or marks no longer in use, from the register.

In the interest of ensuring that registered marks are actually in use in commerce, the USPTO is exploring whether or not there would be a benefit in shortening the first

filing deadline for Affidavits or Declarations of Use or Excusable Nonuse under Sections 8 and 71 of the Trademark Act (15 U.S.C. 1058, 1141k). Therefore, the USPTO is providing the public, including user groups, with an opportunity to comment on the idea of a statutory change to shorten the first filing deadline from between the fifth and sixth years after the registration date, or the six-month grace period that follows, to between the third and fourth years after the registration date, or the six-month grace period that follows. Such a change would necessitate a legislative amendment of the Trademark Act, and thus is beyond the authority of the USPTO, but the USPTO wishes to collect public comment that might assist in the consideration of such an amendment, or another alternative.

The accuracy of the trademark register as a reflection of marks that are actually in use in the United States for the goods/services identified in the registration serves an important purpose for the public. Members of the public rely on the register to clear trademarks that they may wish to adopt or are already using. When a party searching the register uncovers a similar mark, registered for goods or services that may be related to the searching party's goods or services, that party may incur a variety of resulting costs and burdens in assessing and addressing potential consumer confusion. Such costs and burdens may include changing its mark, investigative costs to determine the nature and extent of use of the similar mark and to assess whether any conflict exists, or cancellation proceedings or other litigation to resolve a dispute over the mark. If a registered mark is not actually in use in the United States, or is not in use on all the goods/services recited in the registration, these costs and burdens may be incurred unnecessarily. Thus, improving

the accuracy and reliability of the trademark register helps reduce such costs and burdens, and thereby benefits the public.

The current requirement to file an affidavit of use or excusable nonuse during the fifth year after registration developed in 1939. Reasons for adding the requirement included removing deadwood from the register, showing that a mark was still in use at the time it became incontestable, and to correspond to English law. See Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents, 76th Cong. 72-74 (1939).

For marks registered under Section 44(e) (15 U.S.C. 1126(e)) or Section 66(a) (15 U.S.C. 1141f(a)) of the Trademark Act, no specimen of use in commerce in the United States is required prior to registration. In addition, recent research indicates that a significantly higher percentage of businesses fail during the first two years after their establishment than during the three years that follow. See SBA Office of Advocacy, Frequently Asked Questions (Jan. 2011), http://www.sba.gov/sites/default/files/sbfaq.pdf. Thus, use of marks registered by such failed businesses may have ceased long before the first Section 8 or 71 affidavit is currently required to be filed. Therefore, the proposed amendment would help ensure the accuracy of the trademark register by more promptly cancelling marks that are not in use.

The USPTO notes that shortening the first filing deadline for Affidavits or Declarations of Use or Excusable Nonuse under Sections 8 and 71 would foreclose the ability that currently exists to combine the filing of an Affidavit or Declaration of Incontestability under Section 15 of the Trademark Act with the first-filed Section 8 or 71

affidavit (see 15 U.S.C. 1065). However, the Section 15 affidavit is optional, and it is often filed independently of the Section 8 or 71 affidavit. Moreover, any impact on the ability to file it in combination with a Section 8 or 71 affidavit should be considered within the context of a more accurate register, where deadwood is removed several years sooner.

Please consider responding to the following questions in your comments:

(1) Is "deadwood" on the trademark register a concern of yours, and what impact do you believe it has?

(2) Do you favor or oppose an amendment to shorten the first filing deadline for Affidavits or Declarations of Use or Excusable Nonuse under Sections 8 and 71 as a means of ensuring the accuracy of the trademark register? (Please explain why.)

(3) If you favor shortening the deadline, what time period do you believe would be most appropriate for the first filing deadline?

(4) Are you concerned that an amendment to the first Section 8 and 71 affidavit deadline would foreclose the ability to combine the filing with the filing of an Affidavit or Declaration of Incontestability under Section 15? What impact do you believe separating these filings would have?

While the USPTO welcomes and values all comments from the public in response to this request, these comments do not bind the USPTO to any further actions related to the comments. Persons submitting written comments should note that the USPTO will

not provide ‘‘comment and response’’ analysis, since notice and opportunity for public comment are not required for this notice under 5 U.S.C. 553(b) or any other law.

Date:August 10, 2012

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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